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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941.

NO. 991.

EDWIN L. WIEGAND COMPANY AND
EDWIN L. WIEGAND,

Petitioners,

vs.

HAROLD E. TRENT COMPANY AND
HAROLD E. TRENT,

Respondents.

REPLY BRIEF FOR PETITIONERS ON PETITION FOR WRIT OF CERTIORARI

HADLEY F. FREEMAN,
Counsel for Petitioners.

1310 Hanna Building,
Cleveland, Ohio.

THE GAYER LEGAL PUBLISHING CO., CLEVELAND, OHIO

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FOREWORD

In petitioners' view, this is not an ordinary patent case, and there is ample reason for granting the writ.

Further, the Circuit Court of Appeals affirmed only for want of invention. (R. 62-63.) Also, the entire proceedings in the District Court, subsequent to the filing of the disclaimer, were on the basis that the disclaimer made no change in regard to infringement of the claims if valid.

I (a)

This section of the Brief for Respondents is predicated on the facts of the Cutler-Hammer suit, that the District Court held the claims valid, but not infringed by the Cutler-Hammer elements, and that the Circuit Court of Appeals affirmed on non-infringement, without passing on the holding of validity.

Respondents agree that these facts are set forth in the Petition and Brief, and argue that therefore it is plain that

there is no conflict between decisions of Courts of Appeals. Apparently respondents refer to the first situation of paragraph (b) of section 5 of Rule 38:

> Where a circuit court of appeals has rendered a decision in conflict with the decision of another circuit court of appeals on the same matter; * * *.

Of course, the Rule is explicit that the situations enumerated are neither controlling nor fully measure the Court's discretion, but it seems that the present case is well within the spirit even of the particular situation, under the circumstance that petitioners took every step toward securing a decision on the holding of validity, and that because of the general recognition of the patent throughout the industry, any basis for another suit is not likely to occur. (*Exhibit Supply Co. v. Ace Patents Corporation* and two other cases, numbers 154-156, decided February 2, 1942.)

Against that conclusion respondents propose that the holding of validity in the *Cutler-Hammer* suit be disregarded entirely.

Respondents argue that there is no real basis for saying that the patent was held valid, for the basis of the decision was non-infringement, and quote Judge Kirkpatrick in support. However, it is manifest from the report of the Special Master and the decision of the District Court, that the validity of the patent was very much in issue. (Exhibit D-66, not printed, and Exhibit D-65, R. 221-223, offered at R. 140.) Consequently it was quite in order for the Master and the District Court to find as to validity. (*Interstate Circuit, Inc., et al. v. United States*, 304 U. S. 55.) Further, obviously any finding of validity did not cease to be a judicial determination merely because ultimately it was not necessary to the final disposition of the suit.

Finally respondents propose to dispose of the holding of validity in the decree of the District Court on the rule

of *Electrical Fittings Corporation et al. v. Thomas & Betts Co. et al.*, 307 U. S. 241.

No doubt Cutler-Hammer could have required that the holding of validity be omitted from the decree. On the contrary, Cutler-Hammer approved the decree. (R. 225-226.) Respondents secured leave to and offered the decree. (A-93-94.) And thereupon it seems that the decree is sufficient evidence that the District Court adjudged the patent valid.

I (b)

In this section respondents argue that there is no conflict because "The patent finally held invalid by the Courts of the Third Circuit was not the same patent as that considered by the Sixth Circuit for it has been extensively modified by disclaimers."

The disclaimer limited claims 1, 3, 5, and 12. (Exhibit P-6, R. 201-206, offered at R. 140.) Therefore the disclaimer did not avoid the conflict, unless it be assumed that the "Courts of the Third Circuit," although they held the narrowed claims invalid, would have held the original claims valid.

On the contrary, the District Court held specifically, that the disclaimers "do not change the essence of the patent." (R. 52.) Further, there has been no disclaimer as to claims 8 and 9.

I (c)

In this section respondents argue that there is no conflict because the Muller and Luftfahrzeugbau patents were not before the Court in the Cutler-Hammer case, and that the Cutler-Hammer case therefore was decided on evidence different from that on which the present case was decided.

The record in this suit contains four items from the Cutler-Hammer suit, namely: Exhibit D-66, the report of

the Special Master, not printed, offered at R. 140; Exhibit D-65, the decision of the District Court, R. 221-223, offered at R. 140; Exhibit D-68, the decree of the District Court, R. 225-226, offered at A-93-94; and Exhibit D-69, the opinion of the Circuit Court of Appeals, R. 226-232, offered at A-93-94.

The Muller and Luftfahrzeugbau patents are not identified in these four items. However, many of the patents offered by respondents are not identified in any of the opinions in the present suit. The record in this suit does not show either that the Muller and Luftfahrzeugbau patents were or were not before the Court in the Cutler-Hammer suit.

Petitioners offer to stipulate the facts.

On the other hand, these four items show that there were before the Court in the Cutler-Hammer suit patents showing everything disclosed by the Muller and Luftfahrzeugbau patents, so that in any event the holding of validity in the Cutler-Hammer suit was not the result of any absence of any substance on which the present suit was decided. In fact respondents argue at page 8, that the prior art includes many United States patents which are just as effective.

I (x)

Further in section I (c) respondents contend that the general recognition of the patent in the industry is without significance. However, respondents base this contention on an assumption that the Circuit Court of Appeals held the patent anticipated. On the contrary, the opinion of the Circuit Court of Appeals recognizes explicitly that there was "escape from anticipation" in the "substitution" of material. (R. 62-63.)

Therefore the entire evidence, of the existence of the problem, the efforts at solution, the failure of solution, even the rejection of the solution, and then the success and

recognition, all is material to show that the so-called substitution was beyond skill in the art, and involved invention.

II

Respondents state that petitioners' second ground is based on the assumption that no consideration was given to the claims for the reason that the Court did not quote the claims in full. Respondents add that to say that the Court did not consider the claims solely because the claims were not quoted, is nothing more than unwarranted speculation implying that the Court failed in its duty.

Yet there is nothing in the Petition and Brief even suggesting that the Court should have quoted the claims, or any of the claims, and obviously whether or not the Court quoted the claims, or any of the claims, was entirely immaterial, and respondents' argument fails entirely.

In the footnote respondents recite that petitioners' witness Calhoun stated that in general the Wiegand units comprise "a resistor wire, embedded in a refractory, and sheathed in a metal sheath." Respondents state that this language is almost identical with that used by the Court in describing the invention. It is not apparent how a definition of the invention would be correct because it corresponded to a statement by a lay witness of what the units comprise. On the other hand, the comparison emphasizes the discrepancy of the interpretation. The Court did not limit the invention even to sheathed elements. (R. 62.)

III

Respondents argue that petitioners' third ground "boils down to a contention that foreign patents to Muller and Luftfahrzeugbau do not disclose what the lower Courts found them to disclose," and that "This is a question of fact," to review which this Court will not grant writ of certiorari.

However, there is no dispute as to fact. For example, there is no question but that the Muller patents are silent as to whether or not the insulating material fills the space between the resistor and the sheath, and that the Luftfahrzeugbau patent is silent as to whether any part of the insulating material is integrated into formation positively spacing the resistor from the sheath. The only question is the question of law, whether the Court is entitled to assume one way, and then defeat the patent on the assumption.

The substance of the parenthetical paragraph on page 7 has been answered under section I (c).

In regard to the last paragraph, petitioners believe that a fair reading, particularly of the original opinion of the District Court, requires the conclusion that the District Court based its holding of invalidity on the Muller and Luftfahrzeugbau patents, whether for anticipation or for want of invention. Certainly any doubt would have been resolved had the District Court made findings and conclusions, as petitioners requested (A-94):

> (E) Plaintiffs having then asked leave to present proposed findings of fact and conclusions of law, thereupon plaintiffs' said request was and hereby is denied, and it was and hereby is ordered that the statements of fact and the statements of law in the opinions filed September 14, 1938, and September 27, 1939, shall constitute respectively the findings of facts and the conclusions of law for the purposes of Rule 52 of the Rules of Civil Procedure.

However, certainly the Circuit Court of Appeals held the claims invalid only on the single ground of want of invention over the Muller and Luftfahrzeugbau patents. (R. 62-63.)

IV

Respondents' contention that the Circuit Court of Appeals held the patent invalid as anticipated has been answered under section I (x).

Otherwise respondents contend that "petitioners ask this Court to review the case not because of any conflict with established law but solely on the ground of the application of the law to the facts of this case."

In other words, there is no question as to the facts, and it is entirely a question of law, as to what constitutes patentable invention, and the Circuit Court of Appeals has decided a federal question squarely in conflict with applicable decisions of this Court. (Rule 38, section 5, paragraph 6.)

CONCLUSION

Petitioners pray that the writ of certiorari be granted.

Respectfully,

HADLEY F. FREEMAN,

Counsel for Petitioners.